

REMARKS

Reconsideration of the above-identified patent application in view of the present amendment is respectfully requested.

This amendment amends the specification to delete the paragraph beginning on page 2 at line 26 of the revised specification that was filed on June 13, 2003. This amendment also amends claims 18, 19, 24, 29, and 30. In the amendments to claims 18, 24, 29, and 30 the term "elastic element" has been amended to "spring element." It is respectfully suggested that the amendment to the specification and the amendments to the claims overcome the objections to the specification set forth in the Office Action.

The Office Action on page 2 states that claims 18, 22-25, and 29 were withdrawn from consideration as being drawn to non-elected species. Specifically, the Office Action states that elected Figs. 4a and 4b do not show the elastic element 16 interposed between the housing cover and at least a portion of the bearing shell. The withdrawal of claims 18, 22-25, and 29 from consideration is respectfully traversed.

It is appropriate to use references such as dictionaries, encyclopedias, and treatises in determining the ordinary meaning of the words of a claim. Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed. Cir. 2002). Webster's II, New College Dictionary (1999) sets forth the following definitions:

- a. "interpose" meaning "to place or insert between parts"
- b. "between" meaning "intermediate to"

c. "portion" meaning "a part of a whole"

Thus, the ordinary meaning of the language of claim 29 "a spring element interposed between the housing cover and at least a portion of the bearing shell" is that the spring element is located in a position intermediate to the housing cover and at least part of the bearing shell.

Claim 29 reads on the embodiments illustrated in Figs. 4a and 4b. With reference to Figs. 4a and 4b, the spring element (16 and 16d) is clearly located in a position intermediate to the housing cover (5 and 5d) and at least part (i.e., lower shell part 13 and 13d) of the bearing shell. The specification of the present invention at page 10, lines 14-16 recites that the bearing shell of Figs. 4a and 4b is of a two-part design that comprises upper and lower shell parts. (Original specification, page 9, lines 17-19). Since claim 29 clearly reads on the embodiments of Figs. 4a and 4b, the withdrawal of claim 29 from consideration is improper. Therefore, examination of claim 29 is requested.

Moreover, claim 29 is generic to all of the embodiments of the present invention. Claim 29 recites a "spring element interposed between the housing cover and at least a portion of the bearing shell." One of ordinary skill in the art will recognize that the use of the phrase "at least a portion of the bearing shell" is inclusive of the entire bearing shell. Thus, claim 29 also reads on the embodiment illustrated in Figs. 1, 2, and 3.

Claims 18 and 22-25 also read on the embodiments illustrated in Figs. 4a and 4b. Claims 23-25 are directed

specifically to the two-part design of the bearing shell as illustrated in Figs. 4a and 4b. Since claims 18 and 22-25 clearly read on the embodiments illustrated in Figs. 4a and 4b, the withdrawal of claim 18 and 22-25 from consideration is improper. Therefore, examination of claim 18 and 22-25 is requested.

With regard to the objection to the drawings, Figs. 4a and 4b show the portion of the bearing shell. As set forth above, the bearing shell of Figs. 4a and 4b is of a two-part design that comprises upper and lower shell parts. Figs. 4a and 4b clearly show the spring element (16 and 16d) interposed between the housing cover (5 and 5d) and the lower shell part (13 and 13d) of the bearing shell. Therefore, the objection to the drawings is improper and should be withdrawn.

The Office Action rejected claims 29 and 30 for failing to comply with the written description requirement of 35 U.S.C. §112, first paragraph. It appears that the Office Action mistakenly recited claims 29 and 30 in this rejection instead of reciting claims 30 and 27 for this rejection. The Office Action recites the language "structure interposed between the housing cover and at least a portion of the bearing shell" and cites lines 15-18 of claim 29 as having this language. However, this language does not occur in claim 29. Instead, this language occurs at lines 15-18 of claim 30. Moreover, the rejection states that claim 30 is rejected for depending from rejected claim 29. Claim 30 is an independent claim and, thus, does not depend from claim 29. However, claim 27 depends from claim 30. Thus, the following response,

which traverses the written description rejection, will refer to claims 30 and 27 instead of claims 29 and 30, respectively.

Written description requires that the specification "clearly allow persons of ordinary skill in the art to recognize that the applicant invented what is claimed." See, Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) citing In re Gosteli, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). There is no need for each limitation of the claim to be described exactly, the limitations need only be described such that one of ordinary skill in the art will recognize that the invention includes those limitations. In re Wertheim, 191 USPQ 90, 96 (CCPA 1976). The M.P.E.P. states that "[t]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time [the time of filing] of the later claimed subject matter'" M.P.E.P. §2163.02 citing Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1575 (Fed. Cir. 1985

With regard to the language of claim 30 reciting "structure (amended to "means") interposed between the housing cover and at least a portion of the bearing shell..., " that one of ordinary skill in the art will recognize that the inventor had possession of this claimed subject matter at the time of the filing of the patent application. As discussed above, the term "interpose" means "to place or insert between parts," the term "between" means "intermediate to," and the term "portion" means "a part of a whole." Thus, one of ordinary skill in the

art will recognize that the language of claim 30 "structure (or means) interposed between the housing cover and at least a portion of the bearing shell" means that the structure (or means) is located in a position intermediate to the housing cover and at least part of the bearing shell. Claim 30 further recites "structure (means for)... acting upon the portion to urge the portion..." The specification with reference to Figs. 4a and 4b teaches that the "spring washer 16, 16d ... applies a compressive force permanently acting on the lower shell 13, 13d, which causes the lower shell 13, 13d continuously to advance as wear occurs. (Specification, page 10, line 29 to page 11, line 1; Original specification, page 9, line 29 to page 10, line 1). Thus, according to the specification, the structure (or means) in the embodiments of Figs. 4a and 4b is the spring washer 16, 16d. With regard to Figs. 4a and 4b, the spring washer 16, 16d is located intermediate the housing cover 5, 5d and the lower shell part (13 and 13d) of the two-part bearing shell. Thus, one of ordinary skill in the art will clearly recognize that the inventor had possession of the subject matter of claim 30 at the time of filing of the application. Therefore, the rejection of claim 30 for failing to comply with the written description requirement of 35 U.S.C. §112, first paragraph should be withdrawn.

Claim 27, which depends from claim 30, meets the written description requirement for substantially the same reasons as claim 30. Therefore, it is also requested that the rejection

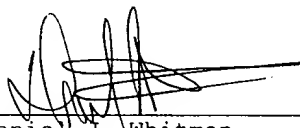
of claim 27 for failure to comply with the written description requirement be withdrawn.

Furthermore, since the Office Action indicated claims 30 and 27 (claim 27 was called claim 31 in the Office Action) as including allowable subject matter, allowance of claims 30 and 27 is respectfully requested.

In view of the foregoing, it is respectfully submitted that the above-identified patent application is in condition for allowance, and allowance of the above-identified patent application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



Daniel J. Whitman
Reg. No. 43,987

TAROLLI, SUNDHEIM, COVELL,
& TUMMINO L.L.P.
526 Superior Avenue, Suite 1111
Cleveland, Ohio 44114-1400
Phone: (216) 621-2234
Fax: (216) 621-4072
Customer No.: 26,294